

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Shmuel Shaffer; Charles J. Bedard
Assignee: Cisco Technology, Inc.
Title: EXTENDING CAMP-ON CAPABILITIES TO INVITEES
TO AN ONGOING CONFERENCE CALL
Application No.: 09/460,089 Filing Date: December 14, 1999
Examiner: Syed Zia Group Art Unit: 2131
Docket No.: CIS0045US Confirmation No.: 1994

Austin, Texas
May 7, 2007

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant hereby requests review of the Final Office Action mailed January 4, 2007 (the "Final Office Action") and of the Advisory Action mailed April 5, 2007 (the "Advisory Action") in the above-identified application. Applicant notes that the Advisory Action sets a period for reply that expired on the mailing date of the Advisory Action. This Request is being filed concurrently with a Notice of Appeal, an Amendment, and a petition for a one-month extension of time that extends the period for reply to May 7, 2007 (since May 5, 2007 was a Saturday).

Claims 1, 3-11, 13-21, 23-30, 33-37, 39-45, 48-52, 54, and 56 are pending in the application. Claims 4, 7, 14, 17, 27-29 and 42-44 are under objection. Claims 1, 3, 5, 6, 8-11, 13, 15, 16, 18-21, 23-26, 30, 33-37, 39-41, 45, 48-52, 54, and 56 stand rejected. The amendments submitted on March 5, 2007 were not entered. The accompanying Amendment amends claims 21 and 54 and cancels claims 22 and 55.

Rejection of Claims under 35 U.S.C. § 101

Claims 21, 23, 54, and 56 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 21 and 54 have been amended in the accompanying

Amendment. Applicant respectfully submits that claims 21, 23, 54, and 56 are patentable under § 101, as discussed below.

The concern in the Final Office Action appears to relate to the limitations of a “signal bearing medium” in independent claims 21 and 54. The Advisory Action refers to the following passage from p. 17 of Applicant’s originally filed Specification:

Examples of a signal bearing media include but are not limited to the following: recordable type media such as floppy disks, hard disk drives, CD ROMs, digital tape, and transmission type media such as digital and analogue communication links using either synchronous or asynchronous communication links (e.g., TDM, packet, ATM, frame based communications links).

In describing this passage, the Advisory Action on pp. 2-3 states that Applicant’s “recordable medium are but not limited to: signal bearing media which can be transmission type media.” Applicant respectfully submits that this description mischaracterizes the above passage.

A person having ordinary skill in the art would read the above passage from the disclosure as providing examples of signal bearing media. The signal bearing media include two categories: “recordable type media,” “and transmission type media.” In turn the recordable type media include examples “such as floppy disks, hard disk drives, CD ROMs, digital tape.” Similarly, the transmission type media include media “such as digital and analogue communication links using either synchronous or asynchronous communication links (e.g., TDM, packet, ATM, frame based communications links.”

Thus, Applicant’s Specification does *not* state that “recordable type media” include transmission type media. Applicant respectfully requests a reconsideration of the rejections under § 101 in view of this observation.

Further, Applicant’s previously pending independent claims 21 and 55 are not directed to raw signals. For example, claim 21 includes a positive limitation of a “signal bearing medium.” Thus, the scope of this claim is limited by requiring something—a medium that carries or otherwise bears a signal. This medium by nature must be a “machine, manufacture, or composition of matter,” and is thus among the explicitly enumerated examples of patentable subject matter in § 101.

The above remarks do not rely on the accompanying Amendment. Thus, Applicant respectfully requests reconsideration of the rejections even if the Amendment is not entered.

In addition, to further prosecution, Applicant submits herewith an Amendment that changes the preambles of claims 21 and 54 to recite a “computer-readable storage medium.” These amendments further emphasize that the claims are limited to a scope that includes patentable subject matter. Applicant respectfully submits that in light of the amendment, independent claims 21 and 54 and all claims dependent therefrom are patentable under § 101.

Rejection of Claims under 35 U.S.C. §102(b)

Claims 1, 3, 5, 6, 8-11, 13, 15, 16, 18-21, 23-26, 30, 33-37, 39-41, 45, 48-52, 54, and 56 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,408,518, issued to Yunoki (“*Yunoki*”). Applicant respectfully submits that the claims are allowable over the cited art because *Yunoki* does not disclose each limitation of the pending claims.

The Final Office Action reiterates the arguments set forth in the previous rejections. In addition, the Final Office Action on p. 3 offers a clarification of the arguments by indicating that *Yunoki*’s “teleconference ID” (introduced in 3:29-33) is the component from the cited reference that supposedly corresponds to the “token” in Applicant’s claim 1. According to the Final Office Action, a user can obtain teleconference data by specifying a teleconference ID. The Final Office Action goes on to argue on p. 3, drawing apparently from *Yunoki* at 7:55-59, that:

This operation enables the teleconference status confirmer in the teleconference to execute the process for allowing any of the teleconference participants to obtain pertinent teleconference data and status confirmation (**persistently or nonpersistently to extend conference capabilities (i.e. to unavailable station) of an ongoing conference call.**)

(Final Office Action at 3 (emphasis added).)

In support of this argument, the Final Office Action cites two lengthy passages from columns 5-7 of *Yunoki* (*Yunoki* at 5:28—6:6, and 6:61—7:47). Applicant respectfully submits that the particular parts of *Yunoki* that the Final Office Action has relied upon have not been designated as nearly as practicable, and the pertinence of the reference has not been clearly explained, both as required by 37 C.F.R. § 1.104(c)(2). Nonetheless, Applicant endeavors to fully address the pending rejections.

The cited portions of *Yunoki* fail to disclose each limitation of Applicant’s claims. For example, Applicant’s claim 1 includes extending a persistent invitation “**after the ongoing conference call has begun.**” Applicant understands the pending rejections as proposing that the

voice message from *Yunoki* is an invitation. However, nowhere in the cited portions of *Yunoki* is there a teaching that a voice message is sent to participants after an ongoing conference has begun. Thus, this limitation is not disclosed in the cited reference.

Further, an example in *Yunoki* implies that a contrary timing relationship exists between the voice message and a teleconference run: the voice message is sent **before** a teleconference run. A procedure receives a request from a call originating subscriber to establish an upcoming teleconference run. (*Yunoki* at 5:13-17.) Invitees are then notified of the upcoming teleconference run. (*Id.* at 5:61—6:5.) After receiving the initial notification of the teleconference run, invitees are offered opportunities to confirm (*Id.* at 7:1-59) or decline (*Id.* at 7:60—8:41) their participation. Only after these initial procedures does the *Yunoki* procedure initiate a teleconference run. “A teleconference participant executes processes . . . for a teleconference absence notification process, a teleconference cancellation process and a teleconference status confirmation process, at any time after the [teleconference notification] process in ST2 and **before** the process in ST6 (a teleconference run process) on request from a controller.” (*Yunoki* at 11:30-37, emphasis added.)

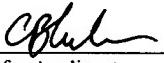
In this example from *Yunoki*, the voice message is sent in advance of the *Yunoki* teleconference run, rather than after the teleconference run has begun. Applicant sees no example in the cited portions of *Yunoki* that teach extending a persistent invitation to join an ongoing conference call after the ongoing conference call has begun. Accordingly, Applicant submits that independent claim 1 and all claims dependent therefrom are allowable under §102(b). Independent claim 11 and all claims dependent therefrom are also allowable at least for similar reasons.

Applicant’s independent claim 24 includes “receiving at an initially unavailable network station client a persistent invitation to join an ongoing conference call, wherein said receiving occurs after the ongoing conference call has begun.” With regard to this limitation, the Final Office Action cites FIG. 1, 2:16-25, and 5:13—6:5 from *Yunoki*. Again, Applicant respectfully submits that the particular parts of *Yunoki* that the Final Office Action has relied upon have not been designated as nearly as practicable. For example, the Final Office Action does not include any indication as to what aspects of *Yunoki* are purported to correspond to the “persistent invitation” or the “initially unavailable network station client” in Applicant’s claim 24.

The cited portions of *Yunoki* set forth a system for automatically holding a teleconference at a specified time on a designated date. The system issues an absence notice in a batch to all other participants when a scheduled participant cannot attend the teleconference. (*Yunoki* at 2:16-25.) The cited portions also describe the teleconference reservation notifier, discussed above, and the voice message for notifying teleconference participants of a teleconference run. (*Yunoki* at 5:61—6:5.) At best, with regard to claim 24, this voice message may be seen as an invitation to a teleconference. However, the cited material does not teach or suggest that the *Yunoki* voice message is received “**at an initially unavailable network station client.**” With regard to the recipients of the voice message, *Yunoki* requires only that their names be obtained by the teleconference reservation notifier system. (*Yunoki* at 5:28-33.) Thus, *Yunoki* fails to disclose the limitation from claim 24 that the receiving is at an initially unavailable network station client. Additionally, the cited material does not teach that the receiving “**occurs after the ongoing conference call has begun,**” as required in Applicant’s claim 24.

With regard to the limitation of “**activating a token**” in Applicant’s claim 24, the Final Office Action proposes on p. 3 that this limitation is met by *Yunoki*’s teleconference ID. However, the cited portions of *Yunoki* presents no teaching that the teleconference ID is activated “**in response to user input to a network station client selected from the group comprising the initially unavailable network station client and another network station client,**” as set forth in Applicant’s claim 24. This shortcoming arises at least because the cited material does not describe the “activating” of the teleconference ID in response to user input. Accordingly, Applicant submits that independent claim 24 and all claims dependent therefrom are allowable under §102(b). Independent claim 39 and all claims dependent therefrom are also allowable at least for similar reasons.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop AE, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia, 22313-1450, on May 7, 2007.

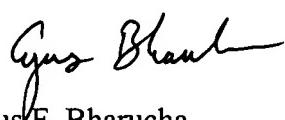


Attorney for Applicant



Date of Signature

Respectfully submitted,


Cyrus F. Bharucha
Attorney for Applicant
Reg. No. 42,324
Telephone: (512) 439-5097
Facsimile: (512) 439-5099